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In re Application of :
Mark Pausch et al :
Serial No.: 09/786,056 : DECISION ON PETITION
Filed: 01 March 2001 :
Attorney Docket No.: 1142.0101 :

This letter is in response to the Petition under 37 C.F.R. 1.144 and 1.181 filed 12 December 2005, requesting review of the restriction requirement set forth in the communication mailed 22 April 2003 and made FINAL in the Office action on the merits mailed 23 September 2004.

BACKGROUND

This application was filed under 35 U.S.C. 371 and accepted on 01 March 2001 and as amended by Preliminary Amendment contained claims 1, 3-4, 6-13, 15-27 and 29-51. On 25 March 2002 a first examiner mailed a Lack of Unity holding to applicants, as follows:

Group I, claims 1, 3-4 and 6-13, drawn to a yeast host cell containing an active heterologous G-protein coupled receptor;
Group II, claims 15-27, drawn to a host cell comprising a heterologous G-protein coupled receptor and a mutation host cell gene;
Group III, claims 29-51, drawn to a host cell comprising a modified G-protein alpha subunit gene.

The examiner also required applicant to elect one of SEQ ID NOs. 1-26 in connection with whichever Group was elected.

Applicants replied on 10 May 2002 electing Group I, but declining to elect a Sequence as such purportedly did not pertain to Group I.

A new examiner set forth a new Lack of Unity holding on 09 September 2002 dividing the claims into 10 groups, as follows:

Group I, claims 1-12 and 27, drawn to a yeast host cell comprising a heterologous G-protein coupled receptor;

Group II, claims 13 and 26, drawn to a method of screening compounds that bind to a G-protein receptor to cause cell growth;

Group III, claims 15-17, drawn to a yeast host cell comprising a mutated gene and a G-protein coupled receptor with improved functional interaction;

Group IV, claims 15-19, drawn to a yeast host cell comprising a mutated gene and a G-protein coupled receptor which does not interact with desensitization machinery;

Group V, claims 15-17 and 20, drawn to a yeast host cell comprising a mutated gene and G-protein coupled receptor with reduced degradation;

Group VI, claims 15-17, drawn to a yeast host cell comprising a mutated gene and G-protein coupled receptor lacking plasma membrane localization;

Group VII, claims 15 and 21-25, drawn to a yeast cell comprising a mutated gene and G-protein coupled receptor with improved sterol ratios;

Group VIII, claims 29-44, drawn to a modified G-protein alpha subunit gene;

Group IX, claim 45, drawn to a modified G-protein alpha subunit protein;

Group X, claims 46-51, drawn to a method of screening compounds that bind G-protein coupled receptor and gene.

The examiner set forth appropriate arguments for the holding.

On 07 February 2003 applicants responded to this second restriction requirement by electing with traverse the claims of Group II, claims 13 and 26. At this time applicants also amended the claims so that claims 13 and 16 were now independent claims and added new claims 52 - 85, all of which depended from either claim 13 or 26, except for claim 81.

On 22 April 2003 the examiner mailed to applicants a third Lack of Unity holding dividing the claims 13, 26, and 52 - 85 into nine distinct groups which are not set forth herein. The examiner also required an election of species if either Group V or Group IX of the new requirement were elected. The examiner argued that new Groups I-IX, a subset of previous Group II were independent and distinct because they comprised different products which have different characteristics in structure and function.

On 22 September 2003 applicants responded to this third requirement by electing with traverse Group IX, claims 70-80, 82, 83, and 85, and the specific human alpha2A adrenergic receptor. Subsequently, the Office included claims 26 and 52 with the other claims of Group IX. See Office action mailed 23 September 2004, page 2.

On 23 September 2004, the examiner mailed to applicants a first Office action on the merits rejecting claims 26, 52, 70 - 80, 83, and 85. Applicants replied on 22 March 2005.

On 12 July 2005 the examiner mailed to applicants a Notice of Non-Responsive amendment because applicants failed to address the objections advanced in the Office action mailed 23 September 2004.

On 11 January 2006 applicants filed a supplemental amendment in which claims 70 and 80 were canceled and other claims were amended to address the outstanding objections.

On 11 January 2006 applicants filed the instant Petition under 1.144 and 1.181 requesting reconsideration of the third Lack of Unity holding mailed 23 September 2004.

DISCUSSION

Applicants' petition is directed to only the third Lack of Unity holding mailed 23 September 2004 because the examiner has for the first time separated claims 13 and 26 into different inventive groups, whereas in the second Lack of Unity mailed 09 September 2002, the examiner indicated that claims 13 and 26 were in the same group because they possessed the same special technical feature. Applicants cannot understand how claims 13 and 26 and the claims depending therefrom can be separated now into nine groups because they form a single inventive concept under PCT Rule 13.1. Applicants have not changed any limitations in claims 13 and 26 except for making them independent claims.

Applicants' argument has been fully considered. Clearly the making of multiple Lack of Unity holdings in an application is discouraged by the Office. That a second Lack of Unity holding was made is perhaps understandable due to change of examiners, but is not normally done. That the second examiner then made an additional Lack of Unity holding following addition of dependent claims is not conducive to the compact prosecution desired by the Office and applicants. Upon review of the holding it is clear that the holding should, at most, have been considered a request for an election of species, not a Lack of Unity holding, based on the fact that applicants have now claimed specific species within the elected Group which were not previously claimed, and it will be so construed. Applicants have complied and elected a species on which prosecution has proceeded. Should the elected species be found allowable over the art, the examiner will follow the guidelines in M.P.E.P. 803.02 for consideration of other species.

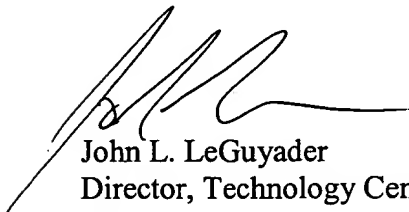
DECISION

For the above reasons, the Petition requesting withdrawal of the third restriction requirement is **GRANTED-IN-PART**. The third Lack of Unity holding is redesignated as an election of species.

The application will be forwarded to the examiner for further consideration of applicants' reply and further action not inconsistent with this decision.

Any request for reconsideration of this decision must be filed within two (2) months of the mailing date of this decision in order to be considered timely.

Should there be any questions regarding this decision, please contact Special Program Examiner, William R. Dixon, Jr. by letter addressed to Director, TC 1600, at the address listed above, or by telephone at 571-272-0519 or by facsimile sent to the general Office facsimile number, 571-273-8300.



John L. LeGuyader
Director, Technology Center 1600
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